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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/581,511

10/06/2000

Raymond Andersen

108281-00000

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07/23/2007

ARENT FOX PLLC

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EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1654

MAIL DATE

DELIVERY MODE

07/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/581,511

Applicant(s)

ANDERSEN ET AL.

Examiner

David Lukton

Art Unit

1654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 51, 58, 61, 63-66, 71, 72 and 76.
Claim(s) objected to: 32, 33, 48-50, 52 and 55-57.
Claim(s) rejected: 23, 25, 31, 35, 37-47, 53, 54, 68-70, 73, 75, 77 and 78.
Claim(s) withdrawn from consideration: 24, 27, 29, 34, 36, 59, 60, 62 and 74.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheets.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Advisory Action

The response filed 6/18/07 proposes to amend several claims. However, the amendment will not be entered. Applicants have had previous opportunities to amend the claims in response to rejections over Johnson (WO 97/04004) and Falender (*Biocat Biotrans*, 1995), and declined to do so.

- Claims 23-25, 27, 29, 31-66, 68-78 remain pending.
- Claims 24, 27, 29, 34, 36, 59, 60, 62, 74 remain withdrawn from consideration.
- The following claims were under examination at the time of the final Office action: 23, 25, 31-33, 35, 37-58, 61, 63-66, 68-73, 75-78.
- Claims 51, 58, 61, 63-66, 71, 72, 76 remain characterized as allowable.
- Claims 32, 33, 48-50, 52, 55-57 remain objected to because of their dependence on rejected claims.



Claims 35, 37; 38-43, 45 46, 54 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

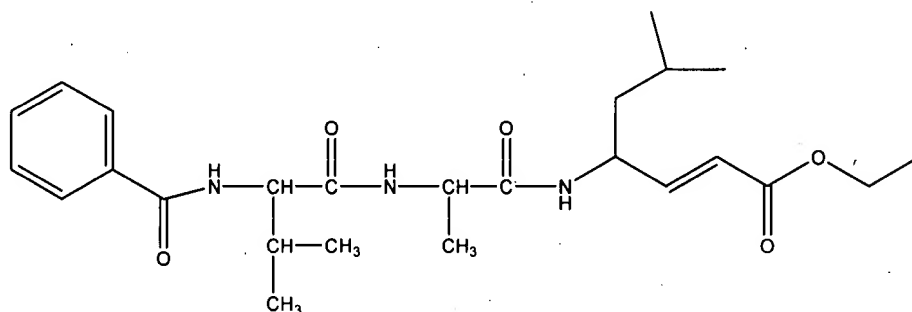
As indicated previously, claim 35 limits R_1 and R_2 to hydrogen, alkyl or acetyl. In the fourth line of text following the structure, the following is recited: "for whichever of R_1 or R_2 is R or $ArR...$ ". However, this is inconsistent with the previous definition of these

variables. The same situation applies in the case of claims 37 & 38. In response, applicants have amended the claims. However, since the amendment is not being entered, the rejection is maintained.

✦

Claims 23, 25, 44, 47, 53, 68-70, 73, 75 are rejected under 35 U.S.C. §102(a) as being anticipated by Johnson (WO 97/04004).

As indicated previously, Johnson discloses compound 26 (page 74), which has the following structure:



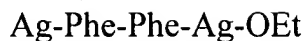
This anticipates the claims for the reasons given previously. In response, applicants have amended the claims. However, since the amendment is not being entered, the rejection is maintained.

✦

Claim 23, 25, 31, 44, 47, 53, 68-70, 73, 75 rejected under 35 U.S.C. §102(b) as being anticipated by Falender (*Biocatalysis and Biotransformation* 13(2), 131-139, 1995).

As indicated previously, Falender discloses the following compound on page 134

("Ag" represents allylglycine):



This anticipates the claims for the reasons given previously. In response, applicants have amended the claims. However, since the amendment is not being entered, the rejection is maintained.



Claims 23, 25, 44, 47, 53, 68-70, 73, 75, 77, 78 are rejected under 35 U.S.C. §103 as being unpatentable over Johnson (WO 97/04004).

The teachings of Johnson are indicated above, and previously. The compound renders the cited claims obvious for the reasons given previously. In response, applicants have amended the claims. However, since the amendment is not being entered, the rejection is maintained.



Claims 23, 25, 31, 44, 47, 53, 68-70, 73, 75, 77, 78 are rejected under 35 U.S.C. §103 as being unpatentable over Falender (*Biocatalysis and Biotransformation* 13(2), 131-139, 1995).

As indicated previously, Falender discloses the following compound on page 134 ("Ag" represents allylglycine):



The compound renders the cited claims obvious for the reasons given previously. In response, applicants have amended the claims. However, since the amendment is not being entered, the rejection is maintained.

Applicants have argued that Falender teaches "merely" the synthesis of tetrapeptide esters, and does not teach which groups are necessary to impart biological activity.

However, Falender also discloses that the tetrapeptide esters can be oligomerized enzymatically (e.g., with subtilisin Carlsberg) to form biodegradable or biocompatible materials. The question is whether or not the provisos in the previous listing of the claims (response filed 12/19/06) were effective to exclude compounds that are rendered obvious by Falender. As it happens, one of ordinary skill would have expected that a tetrapeptide ester in which a phenethylglycine replaces phenylalanine **would** be oligomerized by an enzyme (such as subtilisin Carlsberg) to produce a biodegradable or biocompatible material. Accordingly, the rejection as applied to the claims of 12/19/06 remains justified.

✦

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.



DAVID LUKTON, PH.D.
PRIMARY EXAMINER